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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/092,139	03/06/2002	William D. Tandy	4333.1US (99-0257.1)	9714
24247	7590	10/19/2004	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 10/19/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/092,139

Applicant(s)

TANDY ET AL.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,6-9,11,12,14-17,19,20 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,3,4,6-9,11,12,14-17,19,20 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 8/23/2004.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Introduction***

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 8/23/2004. Applicants' amendments to specification, claims 1, 3, 4, 9, 11, 17, 19 and 20, cancellation of claims 2, 5, 10, 13, 18 and 21 have been entered.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn. In particular, Applicants' amendments to independent claims 1, 9 and 17 overcome the rejection in section 6 of Office action dated 5/18/2004.

### ***Specification***

4. The disclosure is objected to because of the following informalities:

It is noted that while Applicants' amendment to paragraph [0048] overcomes the prior objection in Office action dated 5/18/2004 regarding the missing element 2B in Fig. 5, the Examiner would like to point out that as the result of the previous amendments dated 8/23/2004 and 4/8/2004, Applicants now again fail to address the missing disclosure regarding element 1A in Fig. 5, i.e., there is no corresponding element 1A in the specification (see section 1 of Office action dated 10/8/2003).

Appropriate correction is required.

***Claim Rejections - 35 USC § 112***

5. Claims 1, 3, 4, 6-9, 11, 12, 14-17, 19, 20 and 22-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Despite the extensive corrections, it is noted that the amended claims in their present form are still replete with informalities. For example:

In independent claims 1, 9 and 17, the recitation "a first outermost adhesive layer ... providing a laser-markable surface" appears to be in conflict with the amended recitation "a second adhesive layer ... curing onto ... first outermost adhesive layer or losing adhesive properties for facilitating peeling of the flexible film ...". The Examiner notes that at least in one embodiment, in which the second adhesive layer is cured onto the first adhesive layer (the two layers become integrally one layer), it is not clear to the Examiner as to how would the first adhesive layer is able to provide a laser-markable surface, because neither surface of the first adhesive layer is an outer surface layer, and therefore not accessible for laser marking. Clarification is requested.

***Claim Objections***

6. Claims 7, 15 and 23 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim.

Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

More particularly, for claims 7, 15 and 23, it is noted that they depend upon independent claims 1, 9 and 17, have already clearly recited that the second adhesive layer comprises radiation-curable components, respectively.

***Rejections Based on Prior Art***

7. Claims 1-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Weng et al. (US 5972234), generally as set forth in section 10 of Office action dated 5/18/2004, together with the following additional response to argument.

First, the Examiner repeats (see section 10 of Office action dated 5/18/2004) the relied upon prior art as follows:

Weng's invention is directed to a laser mark tape for marking an electronic substrate. In one embodiment, Weng teaches a marking tape with an identification mark by a high-intensity energy beam (column 2, lines 20-21). Weng teaches that any suitable tape of polymeric based material, which can be easily patterned by high-intensity energy beams such as ultraviolet light or laser, can be used (column 4, lines 27-33), and an release layer, such as polypropylene or PET film, may be provided to cover the adhesive layer for protection during the laser marking process (column 4, line 64 to column 5, line 2).

Regarding the newly amended independent claims, which now recites *inter alia* "a second adhesive layer ... curing onto ... first outermost adhesive layer or losing adhesive properties for facilitating peeling of the flexible film ...", the Examiner notes that the amendment renders the recitation after the term "or" optional, i.e., there is no

requirement for the prior art to provide or account for them, and it does not constitute a limitation in any patentable sense.

As such, in view of the amendments to the claims, the Examiner reiterates the rejection based on prior art as follows:

For claims 1, 7 and 8, in the absence of any distinct difference between the radiation-curable components of the first and second adhesive layers, the examiner notes that Weng's polymeric material based tape, which can be patterned (cured) by high intensity energy beams (UV or laser), reads on both the instantly claimed first and second adhesive layers of the instant invention, since both the first outermost adhesive layer and the second adhesive layer of the instantly claimed invention have the same property (electromagnetic radiation-curable), and in particular that the second layer is cured onto the first layer, i.e., they form one single cured layer. Additionally, Weng's release layer, such as polypropylene or PET film, reads on the instantly claimed flexible film material, and it is common knowledge that polypropylene film is inherently translucent.

For claim 3, the Examiner notes that since the surface of the semiconductor is not a structural element of instantly claimed laser-markable tape of claim 1, whether the surface of the semiconductor bears grinding marks or not is irrelevant to the patentability.

For claims 4-6, the Examiner repeats (see page 8 of Office action dated 5/18/2004) that these claims are directed to the steps of use, and lack any additional structural element. As such, they are clearly improper and informal. The Examiner

suggests that these claims should be re-written as process of use claims. Further, since Weng teaches the same subject matter as the instant invention, as set forth above, it is the Examiner's position that the properties of adhesive layers during process are also anticipated by Weng. It should be noted that where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a *prima facie* case of either anticipation or obviousness has been established. See MPEP § 2112.01.

For claims 9, 11, 12, 14-17, 19, 20 and 22-24, it is noted that these claims are essentially within the same scope, and have the same claimed limitations as claims 1, 3, 4 and 6-8. As such, they are also rejected for the reasons as set forth above.

With respect to Applicants' argument "the Weng et al. reference does not identically describe the elements of the presently claimed inventions of presently amended independent claims 1, 9, and 17 calling for "a tape comprising a flexible film material ... and a multilayer adhesive ..." (Remarks, page 11, top paragraph), the Examiner notes that while Weng appears to teach a simpler tape structure, Weng's teaching does read on each element of the instantly claimed invention. In particular, in the absence of distinct difference between each adhesive layer, Applicants' two adhesive layers fail to preclude Weng's single adhesive layer.

With respect to Applicants' argument "to include radiation-curable components into any adhesive layer formed in the tape disclosed by Weng et al. would render the invention inoperable. Specifically, applying radiation would cure the adhesive layer, which would prevent a pattern from being formed through the tape ..." (Remarks, page

11, bottom paragraph), the Examiner repeats that in one embodiment Weng expressly teaches that any suitable tape of polymeric based material, which can be easily patterned by high-intensity energy beams such as ultraviolet light or laser, can be used (column 4, lines 27-33). As such, while Weng teaches forming a pattern through the marking tape, Weng does teach forming a pattern to the polymeric tape as well, Applicants' argument to the contrary notwithstanding. Further, the Examiner notes that Applicants fail to provide any evidentiary support that a cured adhesive layer would prevent a pattern from being formed through the tape. It should be noted that Attorney arguments cannot take the place of evidence.

### ***Conclusion***

8. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 571-272-1474. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 571-272-1478. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Vsc  
Victor S Chang  
Examiner  
Art Unit 1771

10/8/2004

*Elizabeth M. Cole*  
ELIZABETH M. COLE  
PRIMARY EXAMINER